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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/792,337	03/03/2004	Scott Steffensmeier	2602.68249	4552
48844	7590	02/07/2006	EXAMINER	
GREER, BURNS & CRAIN, LTD. ATTN: JAMES K. FOLKER 300 SOUTH WACKER DRIVE SUITE 2500 CHICAGO, IL 60606			SWIGER III, JAMES L	
		ART UNIT	PAPER NUMBER	
		3733		
DATE MAILED: 02/07/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

JP

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/792,337	STEFFENSMEIER ET AL.
	Examiner James L. Swiger	Art Unit 3733
<p>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</p> <p><b>Period for Reply</b></p> <p>A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.</p> <ul style="list-style-type: none"> <li>- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.</li> <li>- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.</li> <li>- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</li> </ul>		
<p><b>Status</b></p> <p>1)<input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>03 March 2004</u>.</p> <p>2a)<input type="checkbox"/> This action is FINAL.                    2b)<input checked="" type="checkbox"/> This action is non-final.</p> <p>3)<input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i>, 1935 C.D. 11, 453 O.G. 213.</p>		
<p><b>Disposition of Claims</b></p> <p>4)<input checked="" type="checkbox"/> Claim(s) <u>1-19</u> is/are pending in the application.</p> <p>4a) Of the above claim(s) <u>14-16</u> is/are withdrawn from consideration.</p> <p>5)<input type="checkbox"/> Claim(s) _____ is/are allowed.</p> <p>6)<input checked="" type="checkbox"/> Claim(s) <u>1-9, 12 and 17-19</u> is/are rejected.</p> <p>7)<input checked="" type="checkbox"/> Claim(s) <u>10-13 and 19</u> is/are objected to.</p> <p>8)<input type="checkbox"/> Claim(s) _____ are subject to restriction and/or election requirement.</p>		
<p><b>Application Papers</b></p> <p>9)<input type="checkbox"/> The specification is objected to by the Examiner.</p> <p>10)<input checked="" type="checkbox"/> The drawing(s) filed on <u>03 March 2004</u> is/are: a)<input checked="" type="checkbox"/> accepted or b)<input type="checkbox"/> objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).</p> <p>11)<input type="checkbox"/> The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.</p>		
<p><b>Priority under 35 U.S.C. § 119</b></p> <p>12)<input type="checkbox"/> Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).</p> <p>a)<input type="checkbox"/> All    b)<input type="checkbox"/> Some * c)<input type="checkbox"/> None of:</p> <p>1.<input type="checkbox"/> Certified copies of the priority documents have been received.</p> <p>2.<input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____.</p> <p>3.<input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</p>		
<p>* See the attached detailed Office action for a list of the certified copies not received.</p>		
<p><b>Attachment(s)</b></p> <p>1)<input checked="" type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2)<input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3)<input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>3/3/2004</u>.</p> <p>4)<input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.</p> <p>5)<input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>6)<input type="checkbox"/> Other: _____.</p>		

**DETAILED ACTION**

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-12 and 17-19 are drawn to an apparatus, classified in class 606, subclass 102.
- II. Claims 14-16 are drawn to a method, classified in class 606, subclass 88.

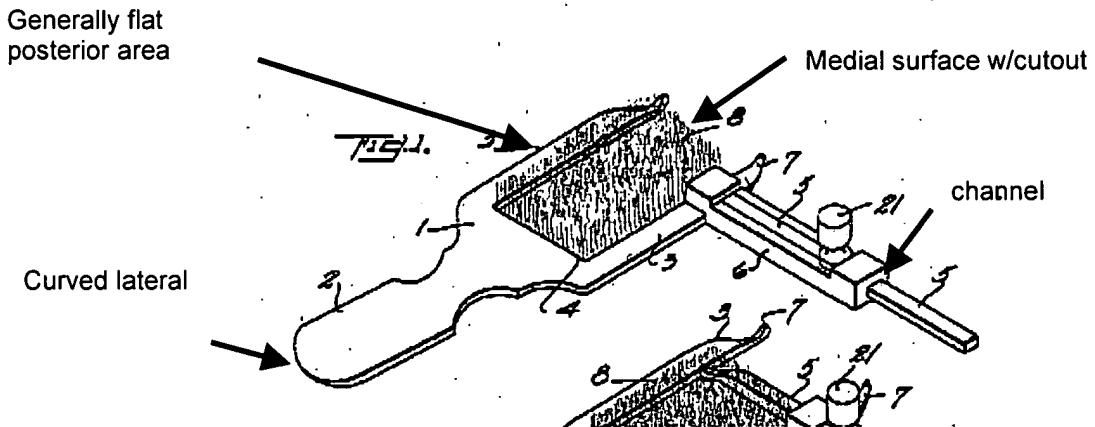
Applicant's election without traverse of Group I (Claims 1-13 and 17-19) in the reply filed on 1/3/2006 is acknowledged.

***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Nessler (U.S. Patent No. 1,962,518). With regard the statement of intended use pertaining to claims 1-5 and other functional statements, they do not impose any structural limitations on the claims distinguishable over Nessler, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Nessler discloses a device having a head (See Fig. 1 below), a handle extending outwardly from the head (6), a channel that extends through at least a portion of the head and handle (Fig. 1), and a slider (5). Nessler also discloses a head that has



a posterior surface that is generally flat (See Fig. 1), a lateral outer surface that is curved (see Fig. 1), and a third medial surface that is generally flat (Fig. 1) and has a cutout portion. Nessler also discloses a hook at the end of the slider (7) capable of making contact with the posterior portion of a proximal tibia, which is cited functionally.

#### ***Claim Rejections - 35 USC § 103***

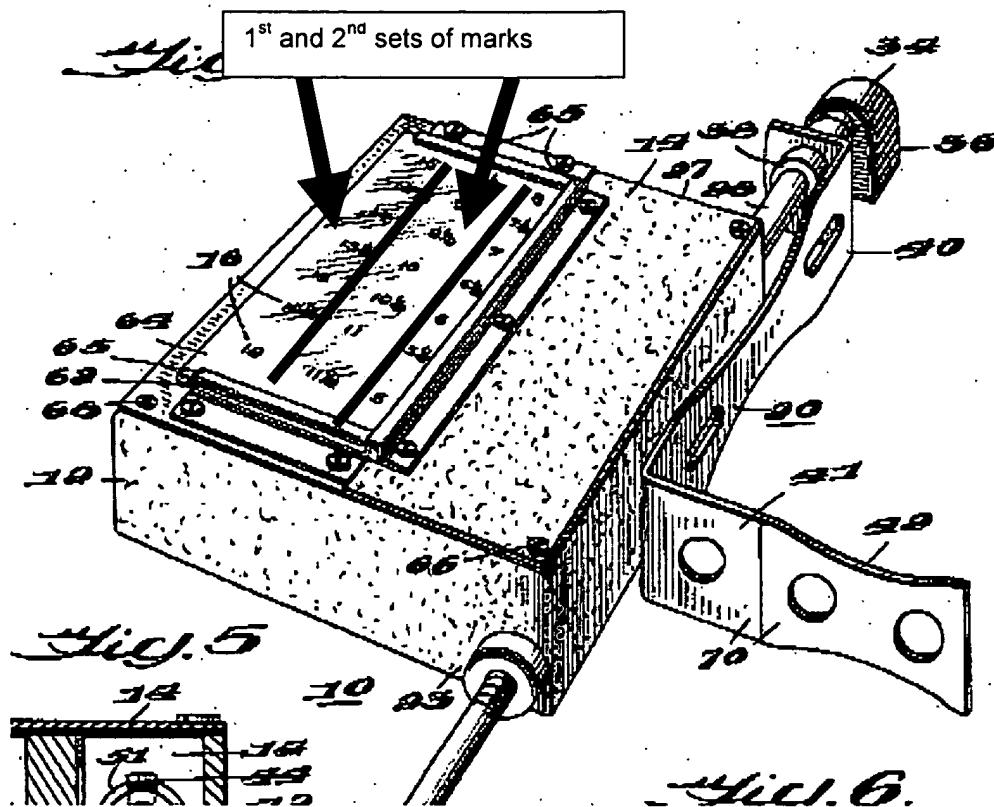
The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 7-9, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (U.S. Patent No. 2,530,477) in view of Peabody et al. (U.S. Patent No. 6,979,299).

With regard the statement of intended use pertaining to claims 1, 7-9, and 12 and other functional statements, they do not impose any structural limitations on the claims distinguishable over the combination of Smith and Peabody et al, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference “teach” what the subject patent teaches, but rather it is only necessary that the claims under attack “read on” something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Smith discloses a device having a head (12), a handle extending outwardly from the said head (42), and a channel (32 and see Fig. 2), and a slider (22) configured to be slidably positioned within the channel. Smith also discloses a device that has a first and second set of markings (Fig. 1b drawn below).



Smith discloses the claimed device except for a slider that includes markings and that can be used independently. Peabody et al. Discloses a measuring guide with a slider that has markings (22), is capable of use with the device of Smith to provide a third set of markings (46), where the markings are not visible when used in the channel of the device of Smith, but are visible when used without the handle of Smith, essentially as a ruler. The modifications of Peabody et al. including the slider with markings and the slider's separate use as a ruler-type device are to facilitate the marking and measuring of the tibial bone in use (See abstract of Peabody et al., Front page). It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Smith having at least a slider having

markings in view of Peabody et al. To better facilitate the measuring of the tibia to select the most appropriate tibia head size.

Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nessler '518 in view of Cloutier (U.S. Patent No. 4,211,228). Nessler '518 discloses a device with the elements listed *supra* except for a plurality of different sized tibial sizers to be used in the invention. Cloutier discloses a multi-purpose tibial template that discloses a set of provisional plateaus of different thicknesses. This teaching of having multiple sized measuring apparatuses discloses then a collective group of items, not just one that is adjustable to meet any size tibia. Cloutier teaches that this ability of having different size members allows for a better fit of the area of interest, preventing misalignment of condylar portion (Col. 1, lines 45-55). It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Nessler having at least a plurality of differently sized sizers in view of Cloutier in order to have a more properly tailored tibial measurement.

#### ***Allowable Subject Matter***

Claims 10-13 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James L. Swiger whose telephone number is 571-272-5557. The examiner can normally be reached on Monday through Friday, 8:30am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



2/1/2006

JLS



EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER